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In re Application of :
Eric C. Bigham et al :
Serial No.: 10/019,976 : PETITION DECISION
Filed: October 23, 2001 :
Attorney Docket No.: PU3650USw :

This is in response to the petition under 37 CFR 1.144, filed October 28, 2003, requesting withdrawal of an improper restriction requirement. The delay in acting on this petition is regretted, but was occasioned by scanning requirements and Office moves.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on October 23, 2001, and contained claims 1-29, as filed. By preliminary amendment concurrently filed claims 18 and 21-23 were deleted. In a first Office action, mailed April 25, 2003, the examiner set forth a restriction requirement under 35 U.S.C. 121, as follows:

- Group I – Claims 1-13 and 19-20, drawn to compounds and compositions of formula 1;
- Group II – Claims 14-17, drawn to a method of treating a disease or condition;
- Group III – Claims 24-29, drawn to a process of preparing the compound of formula 1.

The examiner reasoned that the compounds/compositions were independent and distinct from the method of using and method of preparing them, setting forth appropriate reasoning under 35 U.S.C. 121. The examiner further required an election of species within whichever Group was elected. Pursuant to a telephone interview applicants provisionally elected Group I and the species set forth in Claim 13 for examination. The examiner then examined the species and finding it allowable defined a genus or subgenus within the claim based on the species elected. Having done this the examiner then objected to the claims as containing non-elected species and required cancellation thereof.

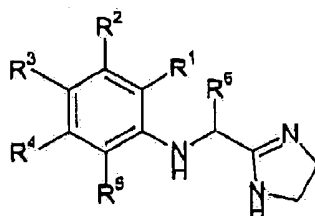
Applicants replied on June 19, 2003, confirming the election of Group I and the species of claim 13. Applicants strenuously traversed the restriction requirement on the basis that it is improper for the examiner to determine what applicants' invention is based on the election of a species and the examiner's construction of a genus or subgenus based thereon. Primarily argued was the procedures outlined in M.P.E.P. 802.03 relating to an election of species when the species is found allowable and that the examiner has not followed the directions therein.

The examiner then mailed a Final Office action to applicants on September 15, 2003, responding to applicants' traversal, but maintaining the requirement for the same reasons as previously set forth. The examiner again objected to the non-elected subject matter in the claims and requested cancellation thereof and made the Office action Final.

Applicants replied by filing this petition which presents the same points of argument as presented in reply to the first Office action in a somewhat expanded form.

DISCUSSION

The application was filed with claims directed to the structure of Formula (I):



The examiner and applicants are both in error with respect to requiring restriction under 35 U.S.C. 121 in this application inasmuch as this application was filed and accepted under 35 U.S.C. 371. In view of this National Stage filing of PCT/EP00/03848, only Unity of Invention rules apply with respect to examination of the claims. Unity of Invention requires an examiner to determine the special technical feature which is found in all of the compounds/compositions claimed and base examination thereon. If no special technical feature is found which makes a contribution over the art then Unity does not exist. Within a Markush type claim, as here, Unity may not exist on the basic structure (Formula I as shown above absent each of the variables) common to all of the compounds, but there may be several different structures which may form the basis for multiple limited Unity of Invention holdings based on the common structure above and one or more radicals attached thereto. That appears to be the case here based on the determination that a species which has been examined is free of the prior art. A requirement for election under Lack of Unity standards does not permit an election of species requirement. However, for purposes of beginning examination an examiner may request and applicants may suggest a particular species from which to start examination.

Further, according to PCT Rule 13.1 a method of making and a method of using a compound/composition are considered to have Unity with the compound/composition found to be free of the prior art.

In view of the error in prosecution of this application by requiring restriction under 35 U.S.C. 121 rather than under 35 U.S.C. 371 and 37 CFR 1.499, **all prior Office actions are vacated** and the application will be returned to the examiner for proper consideration of Lack of Unity and further prosecution.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for further action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in cursive script, reading "Jasenia C. Chambers fa".

Bruce M. Kisliuk
Director, Technology Center 1600